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09/423, 858 02/25/00 BONNET

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EXAMINER

QM32/0327

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ART UNIT

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No. <b>09/423,858</b>	Applicant(s) <b>Bonnet et al</b>
	Examiner <b>Ralph Lewis</b>	Group Art Unit <b>3732</b>

Responsive to communication(s) filed on \_\_\_\_\_.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-34 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-34 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

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### **Objection to the Specification**

The specification is objected to for lacking the headings required in 37 CFR 1.77(b).

### **Rejections based on 35 U.S.C. 112, second paragraph**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 3 and 5-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, lines 1 and 2, “wherein has”?

In claim 3, line 3, there is no antecedent basis for “the upper anterior part.” Additionally, numerals in the claims referencing elements in the Figures must be in parenthesis, e.g. (8).

In claim 5, lines 2 and 4, the language “chosen in” is confusing.

In claim 6, line 4, the “such as” limitation is not understood. Is the “bumps or recesses” limitation required or is not?

In claim 7, it is unclear as to what the “flat, developed shape” is referring or how it relates to the previously claimed “three-dimensional hollow body” required by parent claim 1.

In claim 8, it is unclear to the examiner what the “Bonnets Nighttime Lingual Envelope or N.L.E.” limitation is in reference to; the examiner’s *Illustrated Dictionary of Dentistry* (Jablonski,

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1982, W.B. Saunders Company) does not define the terminology nor does applicant's specification. Moreover, it is unclear how limitations directed to the particular shape that applicant intends for the preform to be formed into at a later point places any objectively ascertainable distinctions on the "preform" which is the subject of the claim.

In claim 9, line 3, is the term "contains" being added or deleted? In line 7, the examiner suggests "a patient." In line 12, the limitation "which becomes functional after finishing" is not understood. Is applicant claiming the finishing step or not?

In claim 10, line 4, ","?

Claim 13 makes no sense.

In claim 18, line 3, ","?

In claim 20, the "insertion by duplicate molding" limitation is not understood.

In claim 22, it is unclear what constitutes "movable anchoring points" or how such points relate to the previously claimed elements.

In claim 23, what "preceding cycle"? There is no antecedent basis for "the preceding cycle."

In claim 24, note the remarks regarding claim 8 above.

In claims 25-31 and 36, it is unclear what applicant is possibly attempting to claim by setting forth an apparatus in a dependent claim which is dependent on a method claim which in turn is dependent on an apparatus claim. Dependent claims are construed to require every limitation set forth in the claims from which they depend, 35 U.S.C. 112, 4th paragraph.

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Additionally, in claim 25, the “means of controlling” is the only limitation set forth for the “core” - thus the claim is improper as a single means claim - see MPEP section 2181, page 2100-161. Accordingly, the claim is herein additionally rejected under the first paragraph of 35 U.S.C. 112.

In claim 26, lines 1 and 2, are the words that are underlined and bracketed being added or deleted? The preamble of claim 21 indicates that an apparatus is being claimed, yet the limitations are directed solely to a method. The confusion is considerable.

In claim 28, it is stated that a “fastening hook” is being claimed in the preamble, but no structure for a hook is set forth. The limitation “called a bent-back segment” is not understood; is applicant attempting to patent a phrase? Word phrases are not patentable. In line 6, there is no antecedent basis for “the apparatus” or “the end of insertion.” It is unclear as to what these phrases are referring.

In claim 29, insufficient structure has been set forth to provide for the limitation of the preamble of a “device for attaching fastening hooks.”

In claim 30, line 1, what “mechanism”? In lines 4 and 5, it is unclear what is bing added or deleted. In line 3, the positive inclusion of the technicians hand as part of the invention is improper.

In claim 31, line 1, what “mechanism” In line 2, there is no antecedent basis for the stable mechanical positioning. In line 3, there is no antecedent basis for “the ends.” In line 4, the “for example” limitation is not understood, is the limitation required or not?

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In claim 32, it is unclear who what the fastening hooks are attached.

In claim 33, the claimed apparatus, has no defined structure. The claim fails to particularly point out what is being claimed.

In claim 34, note the remarks regarding claim 8.

In claim 35, “material registrant”?

In claim 36, what “mechanism”? It is unclear to the examiner if the gun is being claimed as part of the “device for attaching fastening hooks.”

### **Objection to Improper Dependent Claims**

Claims 25-31, 33, 34 and 35 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

In claims 25-31, 35 and 36, it is unclear what applicant is possibly attempting to claim by setting forth an apparatus in a dependent claim which is dependent on a method claim which in turn is dependent on an apparatus claim. In regard to claims 33 and 34, personalized orthodontic apparatus may be made in a manner other than the blow molding method claimed in the parent claim and thus are improper, see MPEP 608.01(n) III, page 600-68.

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**Rejections based on Prior Art**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Nilsson (4,391,861).

Nilsson discloses a hollow thermoplastic preform that is intended to be blow molded.. The particular shape which applicant intends for the preform to be molded into fails to impose any objectively ascertainable structural distinctions from the device disclosed by Nilsson.

Claims 8, 33 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Bonnet's Nighttime Lingual Envelope.

It is unclear how the present claims directed to what applicant admits to be prior art are patentable. Merely setting forth an new process to make an old and known prior art device does not make that prior art device patentable.

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**Allowable Subject Matter**

Claims 9-32, 35 and 36 would be allowable if rewritten to overcome the rejections based on 35 U.S.C. 112, noted above and to include all of the limitations of the claims from which they depend. It is noted in regard to claims 25-31, 35 and 36, that the examiner interprets these claims as requiring all the limitations of the claims from which they depend as required by 35 U.S.C. 112, 4th paragraph, attempts to write them as being directed solely to single device e.g. an expansion core, a fastening hook, a device for fastening hooks . . . etc. will likely bring about a restriction requirement and/or the rejection under prior art.

**Prior Art**

Applicant's information disclosure statement of 15 November 1999 has been considered and an initialed copy enclosed herewith.

Schweitzer (1,896,123), Hall (2,317,763), Jacobsen (4,264,558), Jakobsen (4,320,083), Nilsson (4,391,861), and Breads (4,798,534) are made of record.

Any inquiry concerning this communication should be directed to Ralph Lewis at telephone number (703) 308-0770. Fax (703) 305-3590.

R.Lewis  
March 23, 2001



Ralph A. Lewis  
Primary Examiner  
A u 3732